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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,246	06/27/2000	Toru Ebihara	500.38711X00	5041

20457 7590 10/24/2003

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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,246

Applicant(s)

EBIHARA ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment B, paper number 10, filed on July 14, 2003. Claims 1-9 have been canceled, and new claims 10-17 have been entered.

Final Rejection

Claim Objections

Claim 1 is objected to because of the following informalities: This claim recites the limitation "the way" in line 16. There is insufficient antecedent basis for this limitation in the claim. Claim 1 also recites "...capable dealing..." in line 22. Applicants should consider rewriting it to recite "...capable of dealing..." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 11 recite the conditional statements "when the accepted...", "when a contract...", "when said receiving..." These conditional statements render the claims indefinite since it is unclear to the Examiner what the scope of the claims is when the conditional statements are false. For examination purposes, the Examiner will take

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the broadest reasonable interpretation of the claims and assume that the conditional statements are false since nothing in the Applicants' specification precludes the conditional statements from being false. Therefore, the limitations reciting the conditional statements will not be considered in the analysis of the claims.

Referring to claim 14, it is unclear to the Examiner if the Applicants are attempting to invoke 112, sixth paragraph by reciting the limitations "...for generating map information..." and "...for generating a delivery schedule..." in lines 22 and 33 respectively.

Referring to claim 15, it is unclear to the Examiner if the Applicants are attempting to invoke 112, sixth paragraph by reciting the limitations "...for monitoring whether..." in line 3.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (US Patent 6,336,100 B1) in view of DeLorme et al (US Patent 5,948,040) and further in view of Tsukuda (US 2001/0013007 A1).

Referring to claims 10-17, Yamada teaches a system and method of ordering and delivering merchandise using a computer system opening virtual stores on a network, said computer comprising: a server; a memory unit storing merchandise information, selection information about user's merchandise reception, dealer

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information and delivery schedule information and including an order data file for storing orders from customers (column 2, lines 10-56), said method comprising the steps:

- accepting access to said virtual store from a user terminal connected to the server through the network (column 2, lines 12-17, lines 25-33; Figure 1, items "1" and "3");
- providing merchandise information stored in said memory unit to said user terminal through the network (column 4, lines 41-48; Figure 8);
- accepting an order of merchandise from the user on the basis of said merchandise information (column 4, lines 49-67; column 5, lines 1-12);
- reading selection information concerning a way of receiving said ordered merchandise from said memory unit to provide the read selection information to said user terminal through a network (column 3, lines 6-30)
- accepting a way of receiving merchandise selected based on said read selection information from said user terminal (column 3, lines 6-30);
- accepting a specific dealer selected among the dealers from user terminal (column 3, lines 6-30);
- providing the user terminal with confirmation information including the way of receiving merchandise to the user terminal through the network based on said order information (column 3, lines 55-65).

Yamada does not teach that the merchandise information or the user provided input is written to an order file. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to store all of the information relating to an

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order in an order file. One of ordinary skill in the art would have been motivated to do so in order to retrieve the order information at a later date. Yamada also does not teach monitoring inspection information indicates that said ordered merchandise has arrived at said dealer from said dealer terminal through a communication line in a predetermined period based on a delivery schedule. However, this limitation would also have been obvious to one of ordinary skill in the art, at the time the invention was made. One of ordinary skill in the art would have been motivated to do so in order to allow the virtual store to release an invoice to the dealer and accept payment for the delivered goods. Yamada does not teach providing map information indicating dealers capable of dealing merchandise as a delivery destination, or accepting the specific delivery destination based on the map information. However, DeLorme teaches a system and method of planning an activity using digital maps (Figures 1B-1 and 1B-3). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of DeLorme into the system and method of Yamada. One of ordinary skill in the art would have been motivated to do so in order to allow an individual to plan review, locate, schedule and select or execute customized or personalized travel arrangements and activities in association with map displays as taught by Delorme (column 1, lines 37-65). Finally, Yamada does not teach generating a delivery schedule on the basis of a condition of the contract by referring to information on past delivery schedules. However, Tsukuda teaches a delivery managing system that schedules delivery based on a contract (page 3, paragraph [0039], [0051]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the

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invention was made, to incorporate the teachings of Tsukuda into the system and method of the cited prior art. One of ordinary skill in the art would have been motivated to make the delivery schedule on a legally binding document so that if any disputes were to arise, an appropriate settlement could be made based on the terms of the contract. Although Tsukuda does not teach that the contract is based on past delivery schedules, the Examiner notes that a contract can be based on anything that two parties reach an agreement on. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to base the contract on past delivery schedules. One of ordinary skill in the art would have been motivated to do so in order to use an established business practice as a basis for a contract.

Response to Arguments

Applicant's arguments with respect to claims 10-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Naeem Haq, Patent Examiner
Art Unit 3625

October 6, 2003


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600